

REMARKS

In response to the Notice of Non-Compliant Amendment dated May 14, 2007, the Examiner indicated that the Amendment dated January 8, 2007 does not comply with the requirements of 37 C.F.R. § 1.121. Specifically, in the enclosed Notice, the Examiner indicated that the withdrawn claims have not been properly identified as such. In response, Applicant has resubmitted the Amendment to now include the status identifier "(Withdrawn)" or "(Withdrawn - currently amended)", with each of the withdrawn claims. Applicant believes that the Amendment is now in compliance with 37 C.F.R. § 1.121 and respectfully requests the Examiner's reconsideration and reexamination of this application, and the timely allowance of all the pending claims, in view of the Remarks that follow.

In reply to the Office Action dated September 8, 2006, Applicant has amended claims 1, 6, 9, 19, 27, 32, 33, 35-37, 40-41, 43, 45, 48, 51, 54-57, 64, 67, 72-75, and 77 to clarify the claimed invention, and added new claims 79-83 to protect additional generic aspects of the elected species of the claimed invention.¹ As a result of this Amendment, claims 1-83 are currently pending.

As discussed on page 2 of the Office Action, the Examiner rejected claims 45 and 73 under 35 U.S.C. § 102(b) as being anticipated by Goserud (U.S. Patent No. 5,461,810). And for the reasons set forth on page 3 of the Office Action, the Examiner

¹ Contrary to the Examiner's characterization of Applicant's election of the species of Group II in response to the restriction requirement, Applicant stated that "claims 27, 37, 45, 73, and 77 are also generic to each of these species." See Response to Restriction Requirement dated June 2, 2006 at 2 (acknowledging the Examiner's indication that independent claim 1 is generic). In this election, Applicant also respectfully requested "appropriate rejoinder and examination of any withdrawn claims in the event the Examiner determines that a generic claim is allowable." *Id.*

rejected claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Goserud. The Examiner also rejected claims 5-8, 52, 53 and 76 under 35 U.S.C. § 103(a) as being unpatentable over Goserud in view of Wong (U.S. Patent No. 6,597,934), according to the rationale discussed on pages 3-4 of the Office Action. The Examiner further rejected claims 14, 27, 54, 58, and 77 under 35 U.S.C. § 103(a) as being unpatentable over Goserud in view of Geiser et al. (U.S. Design Patent No. 419,303) based on the rationale discussed on pages 4-5 of the Office Action. The Examiner rejected claims 18-21, 35 and 56 under 35 U.S.C. § 103(a) as being unpatentable over Goserud, in view of Geiser et al., and further in view of Wong, as discussed on page 5 of the Office Action. In addition, the Examiner rejected claim 37 under 35 U.S.C. § 103(a) as being unpatentable over Goserud in view of Duffney (U.S. Patent No. 6, 617,005) for the reasons set forth on pages 5-6 of the Office Action. Finally, as discussed on page 6 of the Office Action, the Examiner rejected claims 39-41 under 35 U.S.C. § 103(a) as being unpatentable over Goserud in view of Duffney, and further in view of Wong.

Goserud, Geiser et al., Wong, and Duffney, however, fail to render the claimed invention unpatentable. Each of the claims recites different combinations of features that distinguish the invention from the prior art. For example, independent claim 1 recites a combination that includes, among other things:

- a display sleeve comprising a top open end, a bottom open end, a substantially flat front side, a border, a window, and a substantially flat back side;

- an article of merchandise having a portion extending through the top and bottom open ends of the display sleeve;

(amended claim 1, ll. 3-11). Independent claim 27 recites a method including, for example:

displaying an article of merchandise so as to permit the article of merchandise to be viewed by at least one customer, wherein an advertisement holder is removably attached to the article of merchandise, the advertisement holder comprising a first side, a second side, at least one connection located between the first side and the second side and extending along a first direction, a first opening and a second opening each located between the first side and the second side, and a window;

inserting a portion of the article of merchandise through the first and second openings of the advertisement holder along a second direction substantially parallel to the first direction;

(amended claim 27, ll. 2-12). Independent claim 37 recites a further combination that includes, among other things:

a sleeve comprising a top open end, a bottom open end, a front side, a border, a window, and a back side,

an article having a portion removably inserted through the top and bottom open ends of the display sleeve,

(amended claim 37, ll. 3-10). Independent claim 43 recites yet another combination that includes, *inter alia*:

a display sleeve comprising a first open end and a second open end, wherein the display sleeve comprises a front side comprising a border and a window having a perimeter defined at least partially by the border, and a back side opposite to the front side, wherein the front and back sides are flexible so as to permit at least a portion of the article of merchandise to be passed into an interior of the display sleeve via the first and second open ends of the display sleeve,

(amended claim 43, ll. 2-8). Independent claim 45 recites still another combination that includes, among other things:

a display sleeve comprising a top open end, a bottom open end, a front side, a back side, and a longitudinal axis;

an article of manufacture having a portion extending along a direction substantially parallel to the longitudinal axis of the display sleeve and extending through at least one of the top and bottom open ends of the display sleeve,

(amended claim 45, ll. 3-10). Independent claim 73 recites a combination that includes, *inter alia*,

a sleeve having a display window, a first open end, a second open end, a front side, and a back side, the sleeve being configured to move between a first sleeve position, where the front side and the back side are substantially planar, and a second sleeve position, where the front side and the back side are substantially bowed outward relative to one another to allow a plurality of different types of articles to be inserted within the sleeve through the first and second open ends,

(amended claim 73, ll. 2-8). Moreover, independent method claim 77 recites a combination of that includes, for instance:

providing a sleeve having a display window, a top end, a bottom end, a front side, and a back side;

moving the sleeve between a first sleeve position, where the front side and the back side are substantially planar, and a second sleeve position, where the front side and the back side are substantially bowed outward relative to one another;

inserting a portion of a first type of article through the top and bottom ends of the sleeve when the sleeve is in the second sleeve position,

(amended claim 77, ll. 2-10). Finally, independent method claim 79 recites a combination of that includes, among other things:

a display sleeve having a longitudinal axis, a first side, a second side connected to the first side by a connector tab located between the first side and second sides and extending along a first direction substantially parallel to the longitudinal axis, a pair of openings each located between the first and second sides and each extending along a second direction substantially perpendicular to the first direction, and a window;

an article having a trolley handle removably inserted through at least one of the pair of openings of the display sleeve along a third direction substantially parallel to the first direction;

(new claim 79, ll. 2-10). At the very least, Goserud, Geiser et al., Wong, and Duffney fail to disclose or suggest any of these exemplary features recited in the independent claims 1, 27, 37, 43, 45, 73, 77, and 79.

To establish anticipation under 35 U.S.C. § 102(b), the Examiner must show that each and every feature recited in these claims is either explicitly disclosed or

“necessarily present” in a single prior art reference, such as within the four corners of the Goserud patent. See M.P.E.P. § 2131 (7th ed. 1998); *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999); *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991). To support a conclusion of anticipation, the Examiner must specifically identify “substantial evidence” setting forth why and how the single prior art reference anticipates each and every feature recited in the claims. See, e.g., *In re Mullin*, 481 F.2d 1333, 1336-37 (CCPA 1973) (An Examiner’s bare assertion that claims were obviously anticipated by a reference did not inform the Applicant as to why the claims lacked novelty.).

Moreover, to make out a *prima facie* case of obviousness, the Examiner must demonstrate (1) that Goserud, as proposed to be modified by the teachings of the Examiner’s own reasoning, or the teachings of Geiser et al., Wong, and Duffney, disclose or suggest each and every feature recited in the claims, (2) that there is a reasonable probability of success in making such modifications, and (3) the existence of some suggestion or motivation, either in the teachings of the applied references themselves or in the knowledge generally available to one of ordinary skill in the art, to make such modification so as to result in the claimed invention. See M.P.E.P. § 2143 (7th ed. 1998). It bears emphasizing that each of these requirements must be found in the prior art — not based on Applicant’s own disclosure. See *id.*

Viewed against this backdrop, each of the Examiner’s factual conclusions must be supported by “substantial evidence” in the documentary record. See *In re Lee*, 61 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 2002). The Examiner has the burden of documenting all findings of fact necessary to support a conclusion of anticipation or obviousness “less

the 'haze of so-called expertise' acquire insulation from accountability." *Id.* To satisfy this burden, the Examiner must specifically identify where support is found within the prior art to meet the requirements of 35 U.S.C. §§ 102(b) and 103. In this case, however, the Examiner has once again failed to satisfy her burden of demonstrating how Goserud, taken alone or in combination with any other prior art reference, can either anticipate or render obvious each and every one of the limitations present in the independent claims, as required by the Manual of Patent Examining Procedure and Federal Circuit jurisprudence.

Goserud discloses a self-framing display holder for flat objects. See Abstract. Goserud, however, fails to provide any disclosure of a display sleeve having a top open end and a bottom open end, and an article having a portion extending through the top and bottom open ends of the display sleeve, as more particularly stated in independent claim 1, as amended. Similarly, Goserud also does not disclose the step of inserting a portion of an article through first and second openings of an advertisement holder, as recited in independent claim 27, as amended. In addition, Goserud does not disclose an article having a portion removably inserted through top and bottom open ends of a display sleeve, as recited in independent claim 37, as amended. Goserud also does not disclose a display sleeve that has flexible front and back sides so as to permit at least a portion of an article to be passed into the interior of the display sleeve via first and second open ends of the display sleeve, as recited in greater detail in independent claim 43, as amended. Goserud does not disclose a sleeve that allows a plurality of different types of articles to be inserted within the sleeve through first and second open ends of the sleeve, as recited in independent claim 45. Goserud further does not

disclose the steps of providing a sleeve with top and bottom ends and inserting a portion of a sleeve through the top and bottom ends of the sleeve, as recited in greater detail in independent claim 77. Finally, Goserud does not disclose an advertising arrangement that includes a trolley handle removably inserted through at least one of a pair of openings of a display sleeve, as recited more particularly in new independent claim 79.

Instead, Goserud discloses the use of a holder that has a spacer strip 18, which seals one end of the holder, as shown in Fig. 2. In contrast, independent claims 1, 27, 37, 43, and 45 call for a display sleeve that has either top and bottom open ends, or first and second open ends. Independent claims 77 and 79 call for inserting a portion of an article, such as a trolley handle, either through top and bottom ends of a sleeve, or through one or more of a pair of openings of a display sleeve. One skilled in the art would understand that the seal end of the holder in Goserud cannot correspond to (1) either "open end" feature recited in claims 1, 27, 37, 43, and 45, (2) either the top or the bottom end feature recited in claim 77, and (3) either one of the pair of "openings" features recited in claim 79. For instance, a sealed end is the antithesis not only the "open end" recited in claims 1, 27, 37, 43, 45, but also the opposite of one of the pair of "openings" recited in claim 79. Also, a skilled artisan would understand that the space strip 18 disclosed in Goserud would prevent a portion of an article, such as a trolley handle, from being inserted through it, as called for by claim 79. These features are neither explicitly stated, nor necessarily present within the Goserud patent disclosure, as required by 35 U.S.C. § 102. Accordingly, Goserud cannot anticipate independent claims 1, 27, 37, 43, 45, 77, and 79.

Turning to the Examiner's secondary grounds for rejection, Geiser et al., Wong, and Duffney all undeniably fail to overcome the deficiencies of Goserud. For example, the Examiner relies upon Geiser et al. solely to allegedly teach the existence of the design of an identification and personalization "cover" that is wrapped around the longitudinal axis of a handle and sealed together along a seal line that extends along a direction parallel to such a longitudinal axis, as shown in Fig. 4. Alternatively, the Examiner relies upon Wong to allegedly teach the existence of "a display including display sleeve (2, 3) and transparent sleeve 6, 7." Office Action at 4. Finally, the Examiner relies upon Duffney to allegedly disclose the existence of a decorative molding/casing that includes a border around a window "including decorative effects 20." *Id.* at 6. As such, one having ordinary skill in the art would readily recognize that these grounds for rejection do not provide any suggestion or motivation for the Examiner's proposed modification of Goserud. Consequently, each of the secondary grounds for rejection fails to remedy the deficiencies of Goserud.


For at least these reasons, Goserud, Geiser et al., Wong, and Duffney fail to disclose or render obvious each and every element recited in independent claims 1, 27, 37, 43, 45, 73, 77, and 79. In addition, claims 2-26, 28-36, 38-42, 44, 46-72, 74-76, 78, and 80-83, which all depend upon one of the independent claims, respectively, recite additional features that are neither disclosed nor suggested by each of the applied references, taken either alone or in combination. Thus, each of the dependent claims are allowable for at least the same reasons discussed above with respect to the independent claims.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of all the pending claims 1-83. Should it be necessary to resolve any additional concerns and expedite the issuance of a Notice of Allowance, the Examiner is invited to contact Applicant's representative at (202) 408-6052.

Please grant any extension of time to the extent required to enter this response and charge any fees required to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

By: 
#207,680 /02
Christopher W. Day
Registration No. 43,944

Date: June 14, 2007